



PATENT
Attorney Docket No. A-67229-13/463077-245/RFT/RMS/RMK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

DAHIYAT, *et al.*

Serial No. 10/665,307

Filed: September 18, 2003

For: *Protein Design Automation for
Protein Libraries*

Group No. 1639

Examiner: Wessendorf, Teresa D.

CERTIFICATE OF MAILING

I hereby certify that this correspondence, including listed
enclosures is being deposited with the United States Postal Service
as First Class Mail in an envelope addressed to: Mail Stop
Amendment, Commissioner for Patents, P.O. Box 1450,
Alexandria, VA 22313-1450 on:

Date:

9/24/04

Signature

Jessica L. Newlin
Jessica L. Newlin

TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Petitioner, Xencor, represents that it is the assignee of the entire right, title, and interest
of:

- (1) the instant application, U.S.S.N. 10/665,307, which is a division application of
U.S.S.N. 09/782,004, filed on February 12, 2001, which claims priority under
35 USC § 119(e) of US Provisional Application Serial Nos. 60/181,630, filed
on February 10, 2000, now abandoned; 60/186,904, filed on March 3, 2000,
now abandoned; and 60/197,851, filed on April 14, 2000, now abandoned;
and,
- (2) U.S. Patent No. 6,403,312, which is a continuation-in-part of U.S.S.N.
09/564,961, filed on May 4, 2000, which claims the benefit of U.S.S.N.

60/104,612, filed October 16, 1998, U.S.S.N. 60/132,475, filed May 4, 1999, U.S.S.N. 60/158,700, filed on October 8, 1999 and U.S.S.N. 60/138,156, filed June 7, 1999.

Written assignment proof for the parent application USSN 09/782,004, is recorded in the U.S. Patent and Trademark Office at Reel/Frame 012070/0692 and was recorded on August 31, 2001. Written assignment proof for U.S.S. N. 09/419,351, filed October 15, 1999, now U.S. Patent No. 6,403,312, is recorded in the U.S. Patent and Trademark Office at Reel/Frame 011517/0330 and was recorded on February 12, 2001. Copies of the Notice of Recordation of Assignment are attached.

Xencor hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§ 154-156 and 173, as shortened by any terminal disclaimer of Serial No. 09/419,351, now U.S. Patent No. 6,403,312. Xencor hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and U.S. Patent No. 6,403,312 are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, Xencor does not disclaim the terminal part of any patent granted on the instant application, that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154-156 and 173 of U.S. Patent No. 6,403,312, as shortened by any terminal disclaimer, in the event that the patent later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321, has all claims cancelled

by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer.

The undersigned is empowered to act on behalf of the petitioner/assignee. The undersigned has reviewed the evidentiary documents in the chain of title of the present application identified above, and certifies that, to the best of assignee's knowledge and belief, title is in the assignee, Xencor.

I, the undersigned, hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that willful, false statements may jeopardize the validity/enforceability of the application or any patent issued thereon.

Dated: September 23, 2004

XENCOR

By: 

Name: Joyce Morrison

Vice President, Intellectual Property



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

OCTOBER 18, 2001

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RECORDATION DATE: 08/13/2001

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BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

DAHIYAT, BASSIL

DOC DATE: 07/06/2001

ASSIGNOR:

HAYES, ROBERT J.

DOC DATE: 07/06/2001

ASSIGNOR:

BENTZIEN, JOERG

DOC DATE: 07/06/2001

ASSIGNOR:

FIEBIG, KLAUS M.

DOC DATE: 07/31/2001

ASSIGNEE:

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111 W. LEMON AVENUE
MONROVIA, CALIFORNIA 91016

SERIAL NUMBER: 09782004
PATENT NUMBER:

FILING DATE: 02/12/2001
ISSUE DATE:

FROM : XENCOR

FAX NO. : 6262563562

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DOROTHY RILEY, EXAMINER
ASSIGNMENT DIVISION
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SAN FRANCISCO, CA 94111-4187**UNITED STATES PATENT AND TRADEMARK OFFICE
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BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

DAHIYAT, BASSIL I.

DOC DATE: 06/15/2000

ASSIGNOR:

HAYES, ROBERT J.

DOC DATE: 06/16/2000

ASSIGNOR:

BENTZIEN, JORG

DOC DATE: 06/16/2000

ASSIGNOR:

FIEBIG, KLAUS M.

DOC DATE: 06/20/2000

ASSIGNEE:

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SERIAL NUMBER: 09419351

FILING DATE: 10/15/1999

PATENT NUMBER:

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